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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,725	01/11/2002	Gerald Tablada Caneba	1992.VIN	4004

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT PAPER NUMBER

1713

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,725

Applicant(s)

CANEBA ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants amended claim 1 introducing the limitation OF BLOCK COPOLYMERS BEING TAPERED.
 2. Claims 5-7 and 9-14 have been cancelled.
 3. Claims 1-4 and 8 are pending.
 4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
 5. Claims 1, 4 and 8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Menzies et al (U.S. 6,410,464). Menzies discloses styrenic rubbers, which are tapered copolymers (col.5, lines 1,2) as pressure sensitive adhesives. A preferred pressure sensitive adhesive is a copolymer of isooctyl acrylate and acrylic acid in the ratio of 94/6 by weight. Therefore, Menzies anticipates the polymer of the instant claim 1. In the event that one of the ordinary skill in the art would not immediately envisage Applicants' instantly claimed copolymer, then the copolymer is rendered obvious from the disclosure found in Menzies. Menzies contains each of Applicants' instantly claimed comonomer in the claimed ratios and clearly suggests to one of ordinary skill in the art that they be used to obtain tapered copolymers as claimed. Such a suggestion renders obvious applicants' instantly claimed copolymers, and as such, the claims are not patentable.
- The rejection of claim 8 is made in the sense of Fitzgerald (205 USPQ 594). (CAFC) based on presumption that the properties governing the claimed copolymers if not taught, may be very well met by the copolymers of Menzies, since the copolymers of

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Menzies are essentially the same as applicants' copolymers, and the burden to show that it is not the case is shifted to applicants; or in the sense of In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

6. Claims 1-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furukawa et al (U.S. 6,455,133).

Furukawa discloses styrenic resin sheet made of a styrene/vinyl monomer copolymer (col.2, lines 59, 60). Copolymerizable vinyl monomers are provided in col.3, lines 5-20 and include the comonomers of the instant claims, such as methacrylic acid, specifically styrene-methacrylic acid copolymer is identified in col.3, line 23, and it is further emphasized that the copolymers can be tapered block copolymers (see col.3, line 34).

Furukawa does not teach the weight ratio of acrylic acid and styrene copolymer, however, since he suggests the tapered block copolymer, that means he suggests the method of making it, such as retrograde polymerization. Furthermore, relative amounts of monomers in a copolymer depend on relative reactivities of comonomers, so called "copolymerization constants", these copolymerization constants being reference values for each pair of comonomers and they mainly define the relative amounts of comonomers in a copolymer. Therefore, a person skilled in the art would have found obvious to perform retrograde polymerization to obtain the suggested tapered block

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copolymers, and to adjust the conditions in order to obtain the claimed ratios, lacking showing criticality of the claimed ratios on this record.

The rejection of claim 8 is also made in the sense of *In re Fitzgerald*, as discussed above.

Response to Arguments

7. Applicant's arguments with respect to claims 1-4 and 8 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

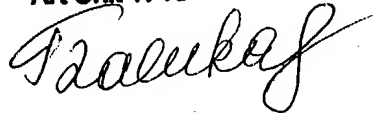
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00 - 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva, Ph.D.
Primary Examiner
Art Unit 1713



February 27, 2004